## REMARKS

Upon entry of this Response, claims 1-20 remain pending in the present invention. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

Claims 1-20 stand under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,901,286 issued to Danknick ("Danknick") in view of US Patent 6,148,346 issued to Hanson ("Hanson"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicant asserts that the rejection of claims 1-20 is improper. Accordingly, Applicant respectfully requests that the rejections of claims 1-20 be withdrawn.

To begin, claim 1 states:

> 1. A method for providing network access to a web server in a peripheral device, comprising the steps of:
> identifying a request from a client received by a host via a network ***to be forwarded to the web server located on the peripheral device locally coupled to the host***;
> ***forwarding the request from the host to the web server located on the peripheral device***;
> ***transmitting a response to the request from the web server located in the peripheral device to the host***; and
> transmitting the response from the host to the client.

With respect to claim 1 the Office Action states:

> "Danknick teaches a method for providing network access to a web server in a peripheral device, comprising the steps of: identifying a request from a client received by a host (element 9 interpreted as a host; see col. 3, lines 52-62) via a network to be forwarded to the web server locally coupled to the host (col. 2, lines 1-9; col. 4, lines 50-60; col. 8, lines col. 11, lines 9-39));..." (Office Action, Page 2)

Applicant respectfully disagrees. Specifically, claim 1 as cited above states that a request is identified from a client that is **received by a host via a network to be forwarded to the web server located on the peripheral device locally coupled to the host**. The "host" identified as element 9 of Danknick does not receive a request from a client to be forwarded to a web server as claimed. Specifically, at column 3, lines 52-62, cited in the Office Action above, Danknick states:

> "Plural workstations, such as workstations 9 and 16, are also connected to the LAN 15, and under control of the network operating system these workstations are able to communicate with the NIB 14. One of the workstations, such as workstation 9, may be designated for use as the network administrator.
>
> In addition, workstations 9 and 16 may each comprise a standard workstation capable of generating data files, transmitting them into the LAN 15, receiving files from the LAN 15, and displaying and/or processing such files. A workstation may also have a printer connected directly to it."

As described above, element 9 may be an administrator computer and does not receive requests from a client that are to be forwarded to the web server that is located on the peripheral device. Also, no peripheral device is locally coupled to the "host" identified as element 9 by the Office Action. Specifically, the workstation that comprises element 9 of Danknick is coupled to a **local area network**. Furthermore, the workstation comprising element 9 does not receive any request that is to be forwarded to a web server, and does not perform any identification of such a request (among any other data traffic received).

In neither the cited portions of Danknick noted above, nor anywhere else does Danknick show or suggest the element of **identifying a request from a client received by a host via a network to be forwarded to the web server located on the peripheral device locally coupled to the host**.

For example, at column 2, lines 1-9, Danknick states:

> "In one aspect, the present invention provides communication between a web browser capable of initiating execution of a platform-independent segment of executable code and a peripheral having an HTTP server and an SNMP agent. A first packet is transferred to the HTTP server, and, in response, a file is transmitted to the web browser. The file contains a reference to a platform-independent segment of executable code. Upon processing the file, this code segment is requested from the HTTP server."

As described above, Danknick merely describes the interaction of a web browser with a web server in a peripheral. There is nothing described herein with respect to identifying a request from a client received by a host that is to be forwarded to the web server in the peripheral device as set forth in claim 1.

In addition, at col. 4, lines 50-60, Danknick states:

> "Broadly speaking, the NIB 14 is an interactive network device which couples the copier 11 to the LAN 15, making the copier 11 a

responsive and interactive network member. The NIB 14 receives copy data, status requests, and control commands from the LAN 15, transmits copy data, status requests, and control commands to the copier 11 for execution, and transmits status information back to the LAN 15. Thus, the NIB 14 can perform not only remote copying services and copy server functionalities, but can also offer to network members whatever status and control features are available from the peripheral interface."

As described above, the web server is located in the Network Interface Board (NIB), not in the peripheral device. In this respect, a request is not received by a host via a network ***to be forwarded to the web server located on the peripheral device locally coupled to the host*** as set forth in claim 1. Also, the response is not transmitted to the host and thereafter directed to the client on the network by the host as claimed. Rather, the web server within the Network Interface Board (NIB) transmits a response directly to the client.

In addition, at col. 11, lines 9-39 cited in the Office Action above, Danknick states:

"In general, according to the process steps in FIG. 6, a first IP-packet sent from a remote service organization is received by a network peripheral device via the IP-network, the first IP-packed including a request for servicing information from the network peripheral device. Next a second IP-packet is sent automatically upon receipt of the first IP-packet from the network peripheral device to the remote service organization via the IP-network, the second IP-packet including the requested peripheral servicing information. Thereafter, a third IP-packet sent from the remote service organization to the network peripheral device via the IP-network is received by the network peripheral device, the third IP-packed including an instruction to execute a peripheral servicing function. Finally, the peripheral servicing function is executed by the network peripheral device automatically in response to the third IP-packet.

More particularly, in step S1801, a service technician operating workstation 1 initiates contact with copier 11 by causing workstation 1 to prepare and send an IP-packet to NIB 14 coupled to copier 11. The IP-packet contains a request for servicing information from network copier 11.

In the following description, the service technician runs a web browser on work station 1, and NIB 14, connected to copier 11, includes an HTTP server which is set up to provide HTML files related to maintenance communications. Accordingly, the service technician can initiate contact with copier 11 by merely entering the address of the maintenance and servicing web page of copier 11 into the browser and executing the browser. Similarly, it is expected that data will be returned in HTML file format. However, it

> is to be understood that the data format used is not limited to HTML."

The above excerpt merely discusses steps for performing remote maintenance and service of a copier as set forth in Danknick. Also, as described above, the web server is located in the Network Interface Board (NIB), not in the peripheral device. Once again, **a request is not received from a client received by a host via a network to be forwarded to the web server located on the peripheral device locally coupled to the host** as set forth in claim 1. Also, the response is not transmitted to the host and thereafter directed to the client on the network by the host as claimed. Rather, the web server within the Network Interface Board (NIB) transmits a response directly to the client. In this situation, the Network Interface Board (NIB) is not a host as set forth in claim 1. As such, the discussion of Danknick in this regard teaches away from such a configuration.

In addition, with respect to claim 1, the Office Action states:

> "Danknick teaches...transmitting a response to the request from the web server to the host; and transmitting a response from the host to the client (FIG. 13A/B, 18, col. 11, lines 45-55." (Office Action, Page 2).

Applicant respectfully disagrees. Specifically, the cited figures 13A/B and 18 do not show the transmission of a response from the web server in the peripheral to the host and thereafter, from the host to the client as claimed. Specifically, such drawings illustrate direct communication between a client and a server in a peripheral device as set forth in col. 7, lines 40-51. Also, FIG. 18 described steps of performing remote maintenance and servicing of a copier over the internet by a service technician at a workstation. Neither FIGS. 13A/B or FIG. 18 show or discuss the concept of transmitting a response from a web server in the peripheral device to a host and thereafter transmitting the response from the host to a client as set forth in claim 1. In addition, at column 11, lines 45-55, Danknick states:

> "In step S1802, copier 11 receives and evaluates the request to determine what data is required to be sent. Copier 11 then retrieves and outputs the data to NIB 14. NIB 14, in turn, then includes the received data in an HTML file using one of the stored HTTP files 65 and its HTTP server 64, and includes the HTML file in an IP-packet. The generated IP-packet, which includes in its destination field the address of workstation 1, is then sent from NIB 14 to workstation 1 successively via LAN 15, router 7, World Wide Web 6 and router 2."

As described in the excerpt above, a request is received by the NIB that includes a web server that then communicates with a copy machine or other peripheral device. Information is obtained from the peripheral device and then the web server in the NIB includes such information in a response that is then transmitted to a client. As such, the NIB does not act as a host that receives and forwards a request to a web server in a peripheral device locally coupled thereto as set forth in claim 1. Rather, the discussion of Danknick in this regard teaches away from such a configuration.

In addition, the Office Action states:

> "Danknick, however, does not expressly and explicitly detail on a server that is located on a peripheral device. It must be noted that a server located on a peripheral device is well known in the art of networking as evidenced by Hanson abstract; col. 2, col. 4, lines 36 et seq and FIG. 2 for fast data transfer and retrieval. According to FIG. 2, it is clear that Hanson discloses a server that is locally or directly connected to a host as recited in the claimed invention. Therefore, one of ordinary skill in the art at the time the invention would be incorporated a server located on a peripheral device into Dominick's communication system because it would have allowed fast communication and data transfer with Danknick host and client system (see abstract and col. 2)."

With respect to the statement above, Applicant has detailed specifically how Danknick fails to show or suggest several of the elements of claim 1 above beyond locating a server in a peripheral device. Specifically, Danknick fails to show or suggest identifying a request from a client received by a host via network to be forwarded to the web server located on the peripheral device locally coupled to the host. Also, Danknick fails to show or suggest forwarding the request from the host to the web server located in the peripheral device and transmitting a response to the request from a web server to the peripheral device in the host. Also, the response is then transmitted from the host to the client. Applicant asserts that Danknick clearly fails to show or suggest each of these elements as set forth above.

Accordingly, Applicant once again asserts that the rejection of claim 1 is improper. Therefore, Applicant requests that the rejection of claim 1 be withdrawn. In addition, claim 6 and 11 include elements similar in scope with that of claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 6 and 11 be withdrawn as well. In addition, Applicant requests that the rejection of claims 2-5, 7-10, and 12-14 be withdrawn as depending from claims 1, 6, and 11, respectively.

In addition, claim 15 as originally filed provides:

> 15. A method in a peripheral device to provide access to a web server in the peripheral device from a network through a host, comprising:
>
> directing a request to the web server, the request being received from a client on the network through the host; and
>
> transmitting a response to the host to be directed from the host to the client via the network.

With respect to claim 15, the Office Action states:

> "Danknick teaches a method in a peripheral device to provide access to a web server in the peripheral device from a network through a host [interpreted as the NIB that enables communication between the peripheral device and a network], comprising: directing a request to the web server, the request being received from a client on the network through the host (Fig. 1; col. 11, lines 24-44); and transmitting a response to the host to be directed from the host to the client via the network (col. 11, lines 44-55).

Once again, Applicant respectfully disagrees. In particular, at column 11, lines 24-44, Danknick states:

> "More particularly, in step S1801, a service technician operating workstation 1 initiates contact with copier 11 by causing workstation 1 to prepare and send an IP-packet to NIB 14 coupled to copier 11. The IP-packet contains a request for servicing information from network copier 11.
>
> In the following description, the service technician runs a web browser on work station 1, and NIB 14, connected to copier 11, includes an HTTP server which is set up to provide HTML files related to maintenance communications. Accordingly, the service technician can initiate contact with copier 11 by merely entering the address of the maintenance and servicing web page of copier 11 into the browser and executing the browser. Similarly, it is expected that data will be returned in HTML file format. However, it is to be understood that the data format used is not limited to HTML.
>
> Once generated, the IP-packet is sent from workstation 1 to NIB 14 successively via router 2, world wide web 6, router 7 and LAN 15, as described in more detail above. NIB 14 then unpacks the IP-packet and passes the data contained in it to copier 11 via XP interface 51."

As described above, the web server is located in the Network Interface Board (NIB), not in the peripheral device. In this respect, a request is not directed to a web server that was received from a client on the network ***through the host*** as claimed. Also, the response is not transmitted to the host and thereafter directed to the client

on the network by the host as claimed. Rather, the web server within the Network Interface Board (NIB) transmits a response directly to the client. In this situation, the Network Interface Board (NIB) fails to act as a host as set forth in claim 15.

Consequently, Applicant respectfully requests that the rejection of claim 15 be withdrawn. In addition, claim 17 includes limitations similar in scope with that of claim 15. Accordingly, Applicant respectfully requests that the rejection of claims 15 and 17 be withdrawn. In addition, Applicant requests that the rejection of claims 16 and 18 be withdrawn as depending from claims 15 and 17, respectively.

In addition, claim 19 provides as follows:

> 19. The method of claim 1, wherein the step of identifying a request from a client received by a host via a network to be forwarded to the web server located on the peripheral device locally coupled to the host, further comprises the steps of:
>
> registering a host listener with an operating system of the host to establish a virtual socket for a port dedicated to the web server located on the peripheral device; and
>
> listening on the virtual socket with the host listener to identify the request that is to be forwarded to the web server on the peripheral device when the request is received by the host from the client.

Claim 20 includes elements similar in scope with that of claim 19 above. With respect to claims 19 and 20, the Office Action states:

> "As per claims 19-20, Danknick teaches all the features of these claims (see rejection above). Furthermore, Danknick teaches the step of establishing of establishing a virtual socket (see col. 8, lines 64 to col. 9, line 8)."

Applicant respectfully disagrees. Specifically, at column 8, lines 64 through column 9, line 8, Danknick states:

> "In step S1319, the JVM executes the applet to obtain information from the copier 11 using the SNMP client created in step S1310. In particular, the JVM instructs the SNMP client to send an IP packet requesting copier information to the SNMP agent 68 within the network copier 11. The SNMP client then sends the IP packet to the SNMP agent 68 using the IP address obtained in step S1301. However, the SNMP agent has a different socket number than that of the HTTP server 64. Accordingly, the SNMP client simply sends the IP packet to the IP address obtained in step S1301, along with a reference to the SNMP agent's socket."

As described above, Danknick merely teaches that the Network Interface Board (NIB) communicates to the peripheral device using the sockets specified. The

above passage does not describe registering a host listener with an operating system of the host to establish a virtual socket for port dedicated the web server located on the peripheral device. Specifically, if the web server is located in the Network Interface Board (NIB) (interpreted by the Office Action as being the host), then how is it that the virtual socket is established for a port dedicated to the web server located on the peripheral device? In addition, Danknick fails to show or suggest employing a host listener that listens on the virtual socket to identify data traffic that is to be forwarded to the web server on the peripheral device. Specifically, how is it that a host listener may be employed in the host itself (element 9 as interpreted by the Office Action) for data traffic destined to the web server on the peripheral device when the web server is in fact not located on the peripheral device and if no data traffic destined to the web server is ever sent to the host in the first place?

Accordingly, Applicant asserts that the rejection of claims 19 and 20 is improper. Therefore, Applicant requests that the rejection of claims 19 and 20 be withdrawn.

In addition, Applicant asserts that the combination of Danknick and Hanson is improper. Specifically, mere conclusory statements or mere reference to common knowledge can not be relied upon as motivation to combine or modify references. Also, conclusory statements cannot be relied upon when dealing with particular combinations of prior art and specific claims. Rather, the rejection must set forth the rationale upon which it relies. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430, (Fed. Cir. 2002). In citing motivation to combine Danknick and Hanson, the Office Action states:

> "Therefore, one of ordinary skill in the art at the time the invention would be incorporated a server located on a peripheral device into Dominick's communication system because it would have allowed fast communication and data transfer with Danknick host and client system (see abstract and col. 2)." (Office Action, Page 2).

However, incorporating a server in the peripheral device of Danknick makes no sense in view of the fact that a web server is already located in the NIB of Danknick. In this respect, Danknick and Hanson are incompatible and teach away from such a combination. Also, in neither the abstract, nor column 2 of Hanson is there any discussion of allowing "fast" communication and data transfer by virtue of placing a web server in a peripheral device. In fact, Danknick is already teaches

communication between the NIB and the peripheral device that is "fast". Nothing would be gained by the proposed combination. In this respect, the references teach away from making the cited combination. Given that the references are incompatible and that there is nothing gained from the combination, the stated motivation above can only be a conclusory statement and the rejection of claims 1-20 over the cited combination of Danknick and Hanson is improper. Accordingly, for this additional reason, Applicant requests that the rejection of claims 1-20 as being unpatentable over the cited combination of Danknick and Hanson be withdrawn.

## CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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